

REMARKS

Status of Claims

Claims 116, 177-182, and 243-303 were pending in the application before entry of the present amendment. Of these claims 181, 182 and 243 stood withdrawn.

Amendments to the Claims

Claims 253, 255, 258-260, 262-279, and 281-285 are amended by the present Amendment in order to clarify whether the claimed limitation refers to the first or second nucleic acid of the claimed system. In addition, certain dependencies have been revised in order to provide proper antecedent basis for each claim limitation (e.g., claims that depended from claim 116 now depend from claim 254). Applicant submits that no new matter has been added by these amendments.

Election of Species

The Examiner has requested an additional election of species. Specifically, the Examiner has requested that Applicant elect:

- one type of first and second molecule from among the species set forth in claims 250-252 (i.e., RNA, DNA, or RNA and DNA) – **in response Applicant elects the species of claim 250 (i.e., RNA)**
- one type of first and second molecule that corresponds to the previous election such that the sequence of the first and second molecule is defined (e.g., crR10, taR12) – **in response Applicant elects the species of claim 300 (i.e., the crR12 / taR12 pair, see Figures 3A-B).**

Claims 116, 180, 244-250, 253-260, 262-279, 281-288, 290-291, 293-294, 296-298, 300, and 302-303 read on the elected species. Applicant acknowledges that upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. MPEP § 809.02(a).

This election of species is made with traverse. Indeed, under PCT Rule 13.2:

“[w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in PCT Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes *over the prior art*” (emphasis added).

MPEP § 1850 clarifies that whether or not any particular technical feature makes a “contribution” over the prior art, and therefore constitutes a “special technical feature,” should be considered with respect to novelty and inventive step, i.e., the rule requires the Examiner to (a) compare the claims with the prior art and (b) demonstrate that the claims do not share a technical feature that renders them novel and inventive over the prior art. In this context we note that the Examiner’s arguments do not reference any prior art:

“[...] the species lack the same or corresponding special technical features for the following reasons: Each species requires a unique sequence that defines a special technical feature that is not shared by the other identified species.”

In particular, the Examiner has failed to provide any prior art showing that the technical features of independent claim 116 (which are shared by all dependent claims) do not qualify as “special technical features” under PCT Rule 13.2. Under this rule, it does not matter if the dependent claims contain further distinct inventions as long as they share a “special technical feature” as a result of their dependence from independent claim 116. In view of this, Applicant would like to take the opportunity to emphasize that claim 116 is not drawn to a sequence-specific invention (e.g., a newly discovered protein target). Instead, the claims are drawn to a system which relies on certain sequence-based properties (e.g., sequence complementarity) and resulting structures (e.g., stem-loop structures) and which can be implemented with a variety of complementary sequences. As a result, focusing on specific sequences would ignore the versatility and scope of the claimed invention.

Applicant would like to thank the Examiner for her careful consideration of this case.
Please charge any additional fees or credit any overpayments that may be required to our Deposit
Account No. 03-1721.

Respectfully submitted,

Dated: February 26, 2009

/Charles E. Lyon/
Charles E. Lyon, D.Phil., J.D.
Registration No. 56,630

CHOATE, HALL & STEWART, LLP
Two International Place
Boston, MA 02110
t (617) 248-4793
f (617) 502-5002
clyon@choate.com